



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,061	01/24/2000	Yoshiki Kawaoka	0905-0226P-SP	6688

7590 06/28/2005
Birch Stewart Kolasch & Birch LLP
P O Box 747
Falls Church, VA 22040-0747

EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
----------	--------------

2162

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,061

Applicant(s)

KAWAOKA, YOSHIKI

Examiner

HUNG Q. PHAM

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/05/2005 has been entered.

Response to Arguments

- Claims 7 and 10 have been amended. The rejection under 35 U.S.C. § 112, first paragraph, of claims 7 and 10 has been withdrawn.
- Applicant's arguments filed with respect to the rejection of claims 7-12 under 35 U.S.C. § 103 have been fully considered but they are not persuasive.

As argued by applicants at pages 7 and 8:

(1) *In the previous Reply filed on August 6, 2004, Applicant argued that Fukada cannot be relied upon to teach or suggest the feature of "an image-file recording controller for changing a file name of the image file that has been read out of the first loadable and removable recording medium to the incremented file-number generated by said incrementing device and recording the read image file on the second loadable and removable recording medium without checking for duplicate file names in the second loadable and removable recording medium" as recited in independent claim 7 and similarly in independent claim 10. Emphasis added. Applicant maintains this argument.*

In the Response to Arguments section of the Final Office Action, the Examiner state "Fukada process could be modified by bypassing the step of checking for duplication." See Final Office Action, page 4. Applicant respectfully notes that "could" is not the proper standard for establishing a prima facie case of

obviousness. Fukada must teach or suggest the feature, but the Examiner has not yet provided such reasoning.

(2) *Applicant demonstrated in the August 4, 2004 Reply that Fukada explicitly teaches away from this recited feature. Namely, Fukada teaches always checking to determine if the file names overlap... Clearly, because a check for duplication file names **must always** be made, Fukada is in complete contrast to the invention as claimed in the present application. Therefore, independent claims 7 and 10 are distinguishable over Fukada.*

(3) *Claims 8, 9, 11 and 12 depend directly or indirectly from independent claims 7 and 10. Therefore, these dependent claims are distinguishable over Fukada for at least the reasons stated with respect to independent claims 7 and 10 as well as on their own merits.*

Examiner respectfully traverses because of the following reasons:

(1) As taught by Fukada at Col. 7, Lines 18-39, overlap examination could be bypassed in case two different memory cards are processed, every time one memory card is accepted, the counter is incremented and the identifying number is assigned by a combination of the reception number and a serial number, e.g., 10 image files *flower04030001001* through *flower04030001010* have been translocated from a first memory card, file names for the next memory card are determined such as *flower04030002001* through *flower04030002010*. In this case the stored file names do not need to be examined, and the processing is faster than example of FIG. 2, since the time for the overlap examination is saved. As seen, the last file-number is read out and incremented, a read out file name from the memory card is changed to the incremented number *without checking for duplicate file names*.

Art Unit: 2162

(2) As discussed above, a check for duplication file name is not always to be made, and could be bypassed as taught by Fukada. Therefore, independent claims 7 and 10 are not distinguishable over Fukada.

(3) Claims 8, 9, 11 and 12 depend directly or indirectly from independent claims 7 and 10. Therefore, these dependent claims are not distinguishable over Fukada.

For the above reasons, examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukada et al. [EP 0 838 767 A2].

Regarding claims 7 and 10, Fukada teaches a method and device for *reading out an image file that has been recorded on a first loadable and removable recording medium and*

Art Unit: 2162

recording said image file on a second recording medium (Fukada, Col. 1, Lines 6-15),
comprising the steps of:

reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium (as illustrated at Col. 7, Lines 18-35, a laboratory system implies a second recording medium included in the system, *image files have been recorded in a laboratory system, e.g., flower04030001001-flower04030001010, and flower04030001010 as a last file-number of flower04030001001-flower04030001010 as file-numbers is identified*);

incrementing the read out last file-number (Col. 7, Lines 21-25 and 28-35, e.g., *flower04030001010 is incremented, and flower04030002001 is used for next image file*); and

changing a file name of the image file that has been read out of the first loadable and removable recording medium to the incremented file-number and recording the read image file on the second recording medium (Col. 7, Lines 18-35, *flower0403000 as a file name of the image file that has been read out from a memory card as the first loadable and removable recording medium is changed to flower04030002001, and recorded in laboratory system as the second recording medium*) *without checking for duplicate file names in the second recording medium* (Col. 7, Lines 25-28),

wherein the file name includes numerical characters (Col. 7, Lines 28-35, e.g., *flower04030002001*).

Fukada fails to disclose the second recording medium is *loadable and removable*. However, Fukada uses a conventional computer as the device for processing image

Art Unit: 2162

files. Such a conventional computer as disclosed, a loadable and removable recording medium as an A drive for a floppy disk is obvious. Fukada further makes a strong suggestion, the picture image filing device specifically means, for example a printing system having the above function and set in a laboratory, a personal computer, a work station or the like (Col. 4, lines 1-5). Thus, instead of processing in a hard drive, a loadable and removable recording medium such as a high capacity disk could be used for storing, e.g., CD.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Fukada device by including a second loadable and removable recording medium when processing the image files from a first storage medium in order to have a more user-friendly environment by giving drive options for storing data such as a displaying of selection including C, A, and E drive to the users when processing the image from a digital camera or a memory card of digital camera.

Regarding claims 8 and 11, Fukada teaches all the claimed subject matters as discussed in claims 7 and 10, Fukada further discloses the steps of *grouping image files, which have been recorded on the second loadable and removable recording medium according to the types of images represented by the image files* (Col. 5, line 49-Col. 6, line 7).

Regarding claims 9 and 12, Fukada teaches all the claimed subject matters as discussed in claims 8 and 11, Fukada further discloses the step of *recording a file name*

Art Unit: 2162

corresponding to each group on the second loadable and removable recording medium (Col. 5, line 49-Col. 6, line 7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E. BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HUNG Q PHAM
Examiner
Art Unit 2162

June 23, 2005



SHAHID ALAM
PRIMARY EXAMINER